UNITED STATES PATENT AND TRADEMARK OFFICE

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AKERMAN SENTERFITT
P. O. BOX 3188
WEST PALM BEACH, FL 33402-3188

EXAMINER
GOODCHILD, WILLIAM J

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/736,025	CREAMER ET AL.
	Examiner	Art Unit	
	William J. Goodchild	2109	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *07/26/2004*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20070509

DETAILED ACTION

Claim Objections

1.   Claims 7-8, 14, 17-19 and 30-31 are objected to because of the following

informalities:

Claim 7, line 3, the phrase "a Weblog" has been defined in claim 1, line 3, it is

suggested to change the phrase to –the Weblog--, in order to improve the clarity of the

claim language.

Claim 8, line 2, the phrase "the identity" has not been defined in the claim. It is

suggested to change the phrase to –an identity--, as this limitation has not been

previously recited in the claim.

Claim 8, line 2, the phrase "the sender" has not been defined in the claim. It is

suggested to change the phrase to –a sender--, as this limitation has not been

previously recited in the claim.

Claim 14, line 7, the phrase "an instant messaging session" has been defined in

claim 14, line 3, it is suggested to change the phrase to –the instant messaging session-

-, in order to improve the clarity of the claim language.

Claim 14, line 8, the phrase "a transcript" has been defined in claim 14, line 2, it

is suggested to change the phrase to –the transcript--, in order to improve the clarity of

the claim language.

Claim 17, line 2, the phrase "the instant messaging client" has not been defined in the claim. It is suggested to change the phrase to –a instant messaging client--, as this limitation has not been previously recited in the claim.

Claim 30, line 3, the phrase "a Weblog" has been defined in claim 24, line 5, it is suggested to change the phrase to –the Weblog--, in order to improve the clarity of the claim language.

Claim 31, line 2, the phrase "the identity" has not been defined in the claim. It is suggested to change the phrase to –a identity--, as this limitation has not been previously recited in the claim.

Claim 31, line 2, the phrase "the sender" has not been defined in the claim. It is suggested to change the phrase to –a sender--, as this limitation has not been previously recited in the claim.

Any claim not specifically addressed above, is being objected to as incorporating the deficiencies of a claim upon which it depends.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-33 and 38-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15-36 and 38-39 can be considered to be software in accordance with

applicants specification, (paragraph 0045, lines 1-2, "The present invention can be

realized in hardware, software, or a combination of hardware and software"). In order

for a claim to be statutory, it must fall within a process, machine, manufacture, or a

composition of matter. Software does not fall within a statutory category since it is not a

series of steps or acts to constitute a process, not a mechanical device or combination

of mechanical devices to constitute a machine, not a tangible physical article or object

which is some form of matter to be a product and constitute a manufacture, and not a

composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-3, 5, 15-17, 19, 24-26 and 28 are rejected under 35 U.S.C. 102(b) as

being anticipated by Linsey et al. (hereinafter Linsey), (US Patent No. 6,791,582).

In reference to claims 1, 15, 16 and 24, Linsey teaches a method comprising:

(a) establishing an instant messaging session, (column 2, lines 37-38, column

30, line 64 – column 31, line 6, a system which facilitates instant messaging using a

chat session);

(b) receiving a user request to publish a transcript of the session to a Weblog, (column 32, lines 25-27, Users may be allowed to copy the transcripts of a chat into a QuickPlace page, or to save the chat as a whole as a page, column 5, lines 11-13); and

(c) publishing the transcript to the Weblog, (column 32, lines 25-27, copy the transcripts of a chat into a QuickPlace page).

In reference to claims 2 and 25, Linsey teaches the method of claims 1 and 24 wherein:

said steps (a), (b), and (c) are performed by an instant messaging client, (column 2, lines 37-38, a system which facilitates instant messaging).

In reference to claims 3, 17 and 26, Linsey teaches the method of claims 2, 16 and 25 further comprising:

saving the transcript to a portion of memory that is local to the instant messaging client, (column 32, lines 35-31, Users may be allowed to copy the transcripts of a chat).

In reference to claims 5, 19 and 28, Linsey teaches the method of claims 3, 17 and 26 further comprising:

receiving a second user input requesting that the transcript be sent to the Weblog; and sending the transcript to the Weblog, (column 32, lines 25-31, Users may be allowed to copy the transcripts of a chat).

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

6.   Claims 1-3, 9-12, 14-17, 20, 22, 24-26, 32 and 35 are rejected under 35

U.S.C. 102(e) as being anticipated by Galli et al. (hereinafter Galli), (US Publication No.

2005/0086309).

In reference to claims 1, 15, 16 and 24, Galli teaches a method comprising:

(a) establishing an instant messaging session, (paragraph 48, lines 2-5, User A

at the device 21 (of figure 2), and User B at the device 22 are communicating across the

Internet 23 in an instant messaging session);

(b) receiving a user request to publish a transcript of the session to a Weblog,

(paragraph 52, the user can share the select online service in the IM session, paragraph

116, lines 2-7); and

(c) publishing the transcript to the Weblog, (paragraph 109).

In reference to claims 2 and 25, Galli teaches the method of claims 1 and 24

wherein:

said steps (a), (b), and (c) are performed by an instant messaging client,

(paragraph 48, lines 2-3 and paragraph 37, lines 1-4 and figure 1A).

In reference to claims 3, 17 and 26, Galli teaches the method of claims 2, 16 and

25 further comprising:

saving the transcript to a portion of memory that is local to the instant messaging

client, (paragraph 54, lines 5-9, Upon clicking on the send button, the user's message is

posted in the communication window).

In reference to claims 9, 20 and 32, Galli teaches the method of claims 1, 16 and

24 further comprising:

exchanging electronic documents within the instant messaging session,

(paragraph 51, lines 1-3, the IMLet makes the third party service represented by the

IMLet immediately accessible in the IM session),

wherein the electronic document is saved as part of the transcript, (paragraph 77

– 84, example of how content is part of the transcript, figure 4).

In reference to claims 10 and 33, Galli teaches the method of claims 9 and 24

wherein:

the electronic document specifies multimedia content, (paragraph 58, figure 4, a

movie link is specified).

In reference to claims 11, 21 and 34, Galli teaches the method of claims 2, 16 and 25 further comprising:

joining a Weblog agent to the instant messaging session, wherein the Weblog agent records transactions of the instant messaging session, (paragraph 20, lines 1-3, paragraph 116, lines 2-5).

In reference to claims 12, 22 and 35, Galli teaches the method of claims 11, 21 and 34 further comprising:

sending the transcript to the Weblog using the Weblog agent, (paragraph 109).

In reference to claim 14, Galli teaches a method comprising:

one or more instant messaging clients configured to publish a transcript generated during an instant messaging session, (paragraph 109);

a server configured to establish an on-line interactive communication session between at least two of the instant messaging clients, (paragraph 37, lines 1-4, figure 1A); and

a server configured to receive the transcript from the instant messaging client, (paragraph 37, lines 13-15, figure 1A, The IMLet, when registered by a user of the RIM service, runs on the top of the RIM service application);

wherein within an instant messaging session, at least one of said instant

messaging clients automatically publishes a transcript of the instant messaging session

to the server responsive to a user request or a scheduled event, (paragraph 109).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 4, 18, 27 and 37-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Galli et al. (hereinafter Galli), (US Publication No. 2005/0086309) as

applied to claims 3, 17 and 26 above, and further in view of Lehikoinen et al.

(hereinafter Lehikoinen), (US Patent No. 7,069,003).

        Regarding claims 4, 18 and 27, Galli teaches the method as disclosed in claims

3, 17 and 26, wherein claims 4, 18 and 27 further comprises:

responsive to said detecting step, sending the transcript to the Weblog, (Galli,

paragraph 109);

Galli explicitly teaches the limitations of claims 3, 17 and 26 as disclosed above except

for the limitation of:

        detecting a state change in the portion of memory

The general concept of detecting a state change, is well known within the art as illustrated by Lehikoinen which discloses the use of tracking events used as the basis for updating the user's blog, (Lehikoinen, column 4, lines 40 and 51-52), and falls within the realm of common knowledge as obvious design optimization to automate and accelerate the publishing process of sent and received messages.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Galli to include the use of tracking events used as the basis for updating the user's blog as taught by Lehikoinen in order to make use of the well known concept of detecting a state change.

Regarding claims 37-39, Galli – Lehikoinen further teaches:

establishing an instant messaging session, (Galli, paragraph 48, lines 2-5, User A at the device 21 (of figure 2), and User B at the device 22 are communicating across the Internet 23 in an instant messaging session);

9.   Claims 6-8 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linsey et al. (hereinafter Linsey), (US Patent No. 6,791,582) as applied to claims 1 and 24 above, and further in view of "Blogging: Genius Strategies for Instant Web Content", by Biz Stone, Publisher: New Riders, Pub. Date: September 11, 2002.

Regarding claims 6 and 29, Linsey explicitly teaches the limitations of claims 1 and 24 as disclosed above except for the limitation of:

formatting the transcript according to a predefined template.

The general concept of formatting the content using a predefined template, is well known within the art as illustrated by "Blogging: Genius Strategies for Instant Web Content" which discloses the use of templates to separate design from content, ("Blogging: Genius Strategies for Instant Web Content", chapter 16, 3rd paragraph, under "Template Management Systems: The Future of Site Management"), and falls within the realm of common knowledge as obvious design optimization to separate design from content.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Linsey to include the use of templates to separate design from content as taught by "Blogging: Genius Strategies for Instant Web Content" in order to make use of the well known concept of formatting the content using a predefined template.

Regarding claims 7 and 30, Linsey - "Blogging: Genius Strategies for Instant Web Content" further teaches:

wherein the predefined template specifies one of a plurality of Weblogs to which the transcript is published or one of a plurality of sections of a Weblog to which the IM transcript is stored, ("Blogging: Genius Strategies for Instant Web Content", chapter 16, 3rd paragraph, "WebCrimson goes beyond blogging in that you are allowed to create almost any type of site. Here is a list of WebCrimson's standard features:", "Automated templating technology for generating whole new areas of your site with a consistent look and feel including: Single Entry templates, Index templates, Blog templates").

Regarding claims 8 and 31, Linsey - "Blogging: Genius Strategies for Instant Web

Content" further teaches:

> wherein the template specifies instructions for processing the Weblog according

to the identity of the sender, ("Blogging: Genius Strategies for Instant Web Content",

chapter 18, 4th paragraph, "Posting via AIM[TM]" and Figure 18.1).

10.   Claims 13, 23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Galli et al. (hereinafter Galli) as applied to claims 11, 21 and 34 above, and further

in view of "Blogging: Genius Strategies for Instant Web Content", by Biz Stone,

Publisher: New Riders, Pub. Date: September 11, 2002.

Regarding claims 13, 23 and 36, Galli - "Blogging: Genius Strategies for Instant Web

Content" further teaches:

> formatting the transcript according to a template using the Weblog agent,

("Blogging: Genius Strategies for Instant Web Content", chapter 16, 3rd paragraph,

"WebCrimson goes beyond blogging in that you are allowed to create almost any type

of site. Here is a list of WebCrimson's standard features:", "Automated templating

technology for generating whole new areas of your site with a consistent look and feel

including: Single Entry templates, Index templates, Blog templates").

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

"Community Building on the Web", Copyright: Peachpit Press, 2000, by Amy Jo

Kim. – Related to posting IM transcripts.

Fellenstein et al., (US Patent 7,194,536) – Related to monitoring and analyzing

instant messaging account transcripts.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to William J. Goodchild whose telephone number is (571)

270-1589. The examiner can normally be reached on Monday - Friday / 9:00 AM - 5:00

PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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WJG
05/31/2007

JASON CARDONE
SUPERVISORY PATENT EXAMINER